

ESTTA Tracking number: **ESTTA676963**

Filing date: **06/08/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91220816
Party	Defendant Oil Mist Australia Pty Ltd
Correspondence Address	MICHAEL A BONDI DICKE BILLIG & CZAJA PLLC 100 S 5TH ST STE 2250 MINNEAPOLIS, MN 55402-1235 UNITED STATES mbondi@dbclaw.com
Submission	Motion to Extend
Filer's Name	Michael A. Bondi
Filer's e-mail	mbondi@dbclaw.com
Signature	/Michael A. Bondi/
Date	06/08/2015
Attachments	VIPER Motion.pdf(1118168 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Opposition: 91220816
Applicant Oil Mist Australia Pty Ltd
Plaintiff Henkel Corporation

MOTION FOR 30 DAY EXTENSION OF TIME TO ANSWER

Henkel Corporation (“Henkel”) filed a Notice of Opposition with respect to U.S. Applic. No. 79/139,923 for the mark VIPER on February 24, 2015. Pursuant to a Trademark Trial and Appeal Board (“TTAB”) order dated February 26, 2015, Oil Mist Australia Pty Ltd (“Oil Mist”) was to file an Answer by April 7, 2015.

Henkel also filed Opposition No. 91220816 with respect to the U.S. Applic. No. 79/139,694 for the mark VIPER and Design. The deadlines for this related opposition are slightly later than the deadlines for this opposition. In a prior discussion between counsel for Henkel and Oil Mist, filing a request to consolidate these two oppositions was discussed in which it was agreed that such a request would be filed it is was not possible for the parties to settle the oppositions.

On April 2, 2015, counsel for Oil Mist filed a consented motion for a 30 day extension of the deadline for Oil Mist to file its Answer. Pursuant to a request by Henkel, Oil Mist provided Henkel with information about the nature of Oil Mist’s use of the mark on May 1, 2015 (Exhibit 1).

On May 7, 2015, Henkel consented to Oil Mist filing a motion for a 30 day extension of the deadline for Oil Mist to file its Answer. In an email dated May 29, 2015, Henkel indicated that she was waiting for a response from the business unit on the materials previously provided by Oil Mist but requested that Oil Mist provide some additional information (Exhibit 2).

On June 8, 2015, Oil Mist sent an email to Henkel indicating that counsel for Oil Mist was waiting for additional information from Oil Mist, inquiring about the response to the information previously provided to Henkel and requesting a 30 day extension for Oil Mist to file its Answer (Exhibit 3).

In a subsequent call to Henkel, counsel for Oil Mist was informed that counsel for Henkel was not in the office today.

In view of the ongoing dialog between Henkel and Oil Mist regarding exchange of information that could potentially result in settling both of these oppositions, it is requested that the TTAB grant this motion and extend the deadline for Oil Mist to file its Answer for an additional 30 days.

Even though counsel for Oil Mist was unable to secure the consent for this motion, it is believed that counsel for Henkel would have consented to this motion if she would have been available today because counsel for Henkel has previously consented to similar motions especially in view of the recent dialog between the parties.

It is believed that the preceding facts provide a showing of good cause as required by the TBMP.

The undersigned certifies that a copy of this motion is being served upon counsel for Henkel by U.S. Mail.

Opposition: 91220816

Page 3

Dated: 06/08/2015

OIL MIST AUSTRALIA PTY LTD

By: /Michael A. Bondi/

Michael A. Bondi

DICKE, BILLIG & CZAJA, PLLC

Fifth Street Towers, Suite 2250

100 South Fifth Street

Minneapolis, MN 55402

(612) 573-2000

ATTORNEY FOR APPLICANT



DICKE, BILLIG & CZAJA, PLLC
INTELLECTUAL PROPERTY ATTORNEYS

Michael A. Bondi
mbondi@dbclaw.com
Direct: 612.767.2512

Exhibit 1

May 1, 2015

Ms. Amy Span Wergeles
Henkel Corporation
One Henkel Way
Rocky Hill, CT 06067

VIA EMAIL
amy.wergeles@henkel.com

RE: Henkel Corporation v. Oil Mist Australia Pty Ltd
Opposition Proceedings No: 91220869

Henkel Corporation v. Oil Mist Australia Pty Ltd
Opposition Proceedings No. 91220816

Dear Ms. Wergeles:

I write to follow up on our prior discussion to provide additional details from Oil Mist Australia Pty Ltd ("Oil Mist") regarding this matter.

The attached brochure provides more details on the Oil Mist wire rope lubricators. This product has a generally cylindrical shape with a channel that extends through the center thereof. The wire rope lubricator is placed over a rope and then the lubricant is injected under pressure to cause not only the outer surface of the rope but also interior surfaces of the rope to be coated with the lubricant. The Oil Mist wire rope lubricators are thereby quite specialized products that are only suited for a specialized use.

Oil Mist has marketed its VIPER wire rope lubricators and associated lubricants throughout the world for more than 5 years. It is our understanding that Henkel has marketed the VIPERLUBE products throughout the world for more than 10 years.

In spite of the time in which the respective products have been simultaneously marketed, Oil Mist is not aware of a single instance of consumers confusing the respective products. Since neither of the Notices of Opposition reference instances of actual confusion, we are led to believe that Henkel is not aware of any instances of actual confusion.

Based upon our review of the Henkel website, it appears that the channels through which the Henkel products are sold are distinct from the channels through which the Oil Mist products are sold.

A Google search for VIPERLUBE identified 15,200 results. The first 20 pages of these results did not include any reference to Viper Wire Rope Lubricators. The Google recommended searches were:

- Henkel viperlube
- Loctite viperlube high performance synthetic grease
- Viperlube loctite

A Google search for Viper Wire Rope Lubricator identified 4,390 results. The first 20 pages of these results did not include any reference to VIPERLUBE. The Google recommended searches were:

- Raptor wire rope lubricator
- Marine wire rope dressing
- Wire rope lubricator suppliers
- Wire rope lubricator youtube
- Wire rope lubrication methods
- Masto wire rope lubricator

As can be seen from the above searches, there is no overlap between the two product ranges on the internet.


In view of the preceding comments about the significant differences between the respective marks, consumers are not likely to be confused by Oil Mist's use of the marks in our client's trademark applications.

If Henkel agrees to withdraw the oppositions referenced above, Oil Mist would agree to not oppose Henkel's trademark applications for VIPERLUBE and Viper design marks in countries in which Oil Mist has an earlier filed trademark application, which could pose an impediment to Henkel's registration of such marks. The parties would also agree to not object to the continued use of the respective marks.

I look forward to receiving your response. Please contact me if you would like to discuss.

Very truly yours,

DICKE, BILLIG & CZAJA, PLLC


Michael A. Bondi

MAB/ae
Attachment

cc: Oil Mist Australia Pty Ltd.



Michael Bondi - RE: Henkel Corporation v. Oil Mist Australia Pty Ltd

From: Amy Wergeles <amy.wergeles@henkel.com>
To: Michael Bondi <mbondi@dbclaw.com>
Date: 5/29/2015 2:32 PM
Subject: RE: Henkel Corporation v. Oil Mist Australia Pty Ltd

Exhibit 2

Dear Michael –

I am waiting to hear back from our business here. In the meantime, can you tell me the relationship between Oil Mist Australia and the VIPER product? I see the Viper WRL website, but nothing about Oil Mist Australia.

Also – you note in your letter that the Oil Mist wire rope lubricators are “quite specialized products” that are “only suited for a specialized use.” What, exactly, are these products and the specialized use? Do the VIPER products extend to just equipment? Or to the lubricants, also?

Thanks.

Amy

Amy Span Wergeles
Senior Trademark Counsel
Henkel Corporation
One Henkel Way
Rocky Hill, CT 06067
Phone: (860) 571-2661
Amy.Wergeles@henkel.com

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From: Michael Bondi [mbondi@dbclaw.com]
Sent: Friday, May 22, 2015 8:54 AM
To: Amy Wergeles
Subject: Fwd: Henkel Corporation v. Oil Mist Australia Pty Ltd

Amy,

As it has been a few weeks since these materials were sent to you, I am checking on the status of your review.

Michael A. Bondi
Dicke, Billig & Czaja
[612-767-2512](tel:612-767-2512)

>>> On 5/7/2015 at 10:46 AM, Michael Bondi <mbondi@dbclaw.com> wrote:

Amy,

As today is the deadline to answer the oppositions, I am checking on the status.

Please confirm that you consent to a 30 day extension to answer.

Please contact me if you would like to discuss.

Michael A. Bondi

DICKE, BILLIG & CZAJA, PLLC

INTELLECTUAL PROPERTY ATTORNEYS

100 South Fifth Street, Suite 2250 | Minneapolis, MN 55402

Direct: 612.767.2512 | Main: 612.573.2000 | Fax: 612.573.2005

mbondi@dbclaw.com | www.dbclaw.com

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>>> On 5/5/2015 at 12:03 PM, Michael Bondi <mbondi@dbclaw.com> wrote:

Amy,

While I recognize that you are likely also at the INTA meeting, I wanted to check on the status of this matter as the extended deadline to answer the oppositions is May 7, 2015.

If you are at the INTA meeting, I would be pleased to make time in my schedule if you would like to meet to discuss this matter.

I look forward to receiving your comments on the settlement proposal or an indication that you agree to an extension of the deadline to answer the oppositions.

Michael A. Bondi

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>>> On 5/1/2015 at 1:39 PM, Andrea Eichrodt <Andrea.Eichrodt@dbclaw.com> wrote:

Opposition Proceeding Nos.: 91220869 and 91220816

Dear Ms. Wergeles,

Attached please find correspondence regarding the above-referenced matter. Please contact

Michael Bondi if you have any questions.

Regards,
Andrea Eichrodt
IP Legal Assistant

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100 South Fifth Street, Suite 2250 | Minneapolis, MN 55402

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Michael Bondi - RE: Henkel Corporation v. Oil Mist Australia Pty Ltd

From: Michael Bondi
To: Amy Wergeles
Date: 6/8/2015 1:23 PM
Subject: RE: Henkel Corporation v. Oil Mist Australia Pty Ltd
CC: Andrea Eichrodt

Exhibit 3

Amy,

I have not received a response from my client regarding the information requested in your email from May 29, 2015. I sent a reminder to the client on the status of this information. It is my understanding that today is a national holiday in Australia. I hope to have this information for you later this week.

Have you received any feedback from your business people on the information that I previously provided to you?

As today is the extended deadline for our client to answer one of the oppositions, please confirm that you consent to an a 30 day extension for both oppositions.

Michael A. Bondi

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Amy Span Wergeles
 Senior Trademark Counsel
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 One Henkel Way
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